

48



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,199	01/29/2001	Richard W. Simmons	13031.1USU1	9114
23552	7590	03/02/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			NGUYEN, MERILYN P	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/772,199

Applicant(s)

SIMMONS, RICHARD W.

Examiner

Merilyn P Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

Art Unit: 2161

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/21/2005 has been entered.

2. In response to the communication dated 01/21/2005, claims 1-11 and 14-26 are active in this application as the result of the cancellation of claims 12-13.

3. This application claims priority to Provisional Application No. 60/179,696 filed on January 28, 2000.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 and 14-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Regarding claims 1 and 22, lines 4-5, the recitation of "the computer application being configured to receive one or more claims for relief for filing the one or more claims for relief"

Art Unit: 2161

fails to point out what is included or excluded by the claim language. Moreover, the claim language has grammatical error.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-8, 10, 14-17, and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Peterson (US 6,343,271), and further in view of Dyson (US 6,269,399).

Regarding claims 1 and 22, Spurgeon discloses a computer system and a method (See Figs. 2, 3 and 9) for assembling a database (See Fig. 3, 'insurer database', and col. 6, lines 42-43) regarding claimant eligibility for relief in a multiple-party proceeding (See Fig. 3, for example, 'insurer', 'first provider', 'second provider', 'nth provider' et...), the system and method comprising:

- a client computing system ('Insurer Computer', Fig. 3) for providing access via a computer network ('Local area network', Fig. 3) for filing one or more claims for relief in the multiple-party proceeding (See Figs. 2 and 9, and col. 6, lines 24-29), each of the claims for relief comprising first information regarding a claimant and

Art Unit: 2161

second information regarding the claimant's eligibility for relief (See col. 6, lines 29-32); and

- a server computing system for receiving each of the claims for relief via the computer network ('Information-exchange computer', Fig. 2 or Fig. 3); and
- validating each of the claims for relief by comparing either of the first or second information against a pre-defined dataset (See col. 10, lines 19-27).

Spurgeon is silent as to transmitting a computer application for filing claims. On the other hand, Peterson teaches transmitting a computer application for filing claims (Fig. 4, Fig. 9 and 10, and col. 8 line 64 to col. 9, lines 30, and col. 10, line 50 to col. 11, line 5, and col. 15, line 63 to col. 16, line 65, Peterson et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to transmit computer application for filing claims as suggested by Peterson. The motivation would have been to reduce the overall claims processing costs. Since the claims are placed in an electronic form, when the claim is initially submitted, the claim may be transferred and processed electronically by that point. It is also easier to send the electronic form to multiple parties involved in processing claims.

The combination of Spurgeon and Peterson, as set forth above, does not teach validating each of the claims for relief by a computer system. Dyson, on the other hand, teaches a validation processor (50, Fig. 1, Dyson et al.) utilizing a fuzzy logic system, and storing procedures on an expert system to interpret and apply validation rules (Col. 3, lines 52-55, Dyson et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination system of Spurgeon and Peterson to include an expert system such as validation processor of Dyson to do the validating job. One of ordinary skill in

Art Unit: 2161

the database art would have recognized that replacing people with an expert validating system would have made the over all system of Spurgeon more reliable, more predictable, more accurate, and more cost effective as suggested by Dyson since people are more likely to make mistakes than are machines because of human error. Moreover, buying software to validate claims is cheaper than hiring people to do the same validating job. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined “old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.” The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Regarding claims 2 and 23, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claims 1 and 22 respectively, and further discloses the pre-defined dataset includes a class list of known class members potentially eligible for relief (See col. 20, lines 25-27, Spurgeon).

Regarding claim 3, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 1 and further discloses associating a unique personal identifier with each of the claims for relief, the unique personal identifier being capable of uniquely identifying the claimant (See either ‘insured’s id number’ of Fig. 9, or ‘patient SSN’ of Fig. 7, Spurgeon).

Regarding claim 4, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 3, and further discloses associating a unique personal identifier with each of the claims for relief includes associating a reference string with each of the claims for relief (See either 'insured id number' of Fig. 9, or 'patient SSN' of Fig. 7, Spurgeon).

Regarding claim 5, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 4, and further discloses:

- providing the reference string to the claimant prior to receiving each of the claims for relief ('member number', Fig. 5, or 'insured id number', Fig. 9, Spurgeon);  
and
- receiving the reference string with each of the claims for relief (See Fig. 9, and col. 9, lines 54-57, Spurgeon).

Regarding claim 7, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 3, and further discloses associating a unique personal identifier with each of the claims for relief includes associating a keycode with each of the claims for relief ('patient SSN', Fig. 7, Spurgeon)<sup>1</sup>.

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<sup>1</sup> Please note that 'keycode' is unique to a member and can be a social security number as exemplified in applicant's specification.

Art Unit: 2161

Regarding claim 8, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 7, and further discloses receiving the keycode with each of the claims for relief (See col. 9, lines 54-57, Spurgeon).

Regarding claim 10, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 8, and further Spurgeon states: "Once the claims processing department receives the claim, the staff verifies the member's eligibility" (See col. 10, lines 20-22, Spurgeon); here, it is understood that processing claims includes processing the keycode to determine whether the potential claimant may be eligible for relief since keycode is associated with each of the claims.

Regarding claim 14, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses processing at least one of the first and second information to determine whether the potential claimant may be eligible for relief (See col. 10, lines 19-22, Spurgeon).

Regarding claim 15, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 14, and further discloses processing at least one of the first and second information comprises defining a criterion for eligibility for relief and determining whether at least part of the second information meets the criterion (See Fig. 7, and col. 6, lines 37-38, and col. 10, lines 19-22, Spurgeon).



Regarding claim 16, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses storing third information regarding receiving the one or more claims for relief (See col. 7, lines 34-37, Spurgeon).

Regarding claim 17, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 16, and further discloses storing the third information comprises storing one selected from the group consisting of a network address from which each of the claims for relief was received (See col. 7, lines 34-37, Spurgeon), a date when the each of the claims for relief was received (See Fig. 15, and corresponding text, Spurgeon), and a time when each of the claims for relief was received is inherent since the database can be used to store all kinds of data.

Regarding claim 19, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses confirming receipt of the first and second information via the computer network (See col. 10, lines 19-25, Spurgeon).

Regarding claim 20, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing a distribution to eligible claimants in the multiple-party proceeding (See col. 10, lines 28-31, Spurgeon).

Regarding claim 21, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access to the database to at least one

Art Unit: 2161

third party having an interest in the multiple-party proceeding thereby allowing the at least one third party in the multiple-party proceeding to monitor the filing of each of the claims for relief (See Fig. 3, and corresponding text, Spurgeon).

Regarding claim 24, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 22, and further discloses a reference string that has been provided to claimants prior to receiving the first and second information, wherein the reference string is received in connection with the first and second information ('member number', Fig. 5, or 'insured id number', Fig. 9, and col. 9, lines 54-57, Spurgeon), and wherein the validation module processes the reference string to determine whether the claimant may be eligible for relief (See col. 10, lines 20-22, Spurgeon).

Regarding claim 25, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 22, and further discloses a keycode received in connection with the first and second information ('patient SSN', Fig. 7, Spurgeon)<sup>2</sup>, and wherein the validation module processes the keycode to determine whether the claimant may be eligible for relief (See col. 10, lines 20-22, Spurgeon).

Regarding claim 26, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 22, and further discloses the validation module processes at least one

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<sup>2</sup> Please note that 'keycode' is unique to a member and can be a social security number as exemplified in applicant's specification.

Art Unit: 2161

of the first and second information to determine whether the claimant may be eligible for relief (See col. 10, lines 20-22, Spurgeon).

6. Claims 6, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Dyson (US 6,269,399), in view of Peterson (US 6,343,271), and further in view of Miller (US 5,608,784).

Regarding claim 6, Spurgeon/Dyson/Peterson discloses all the claimed subject matter, as set forth above in claim 5, however, Spurgeon/Dyson/Peterson is silent as to comparing the reference string provided to the claimant against the reference string received with each of the claims for relief. On the other hand, Miller discloses comparing the reference string provided against the reference string received (See col. 5, lines 62-65, Miller et al.). Because Spurgeon system, combined with Dyson/Peterson, is used to determine and validate claimant eligibility and request (See col. 10, lines 19-25, Spurgeon), it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate the step of comparing the reference string provided to the potential claimant against the reference string received with each of the claims for relief in the combined system of Spurgeon in view of Peterson, and further in view of Dyson, as suggested by Miller et al. The motivation would have been enhancing authentication in order to provide relief to claimants.

Regarding claim 9, Spurgeon//Peterson/Dyson/Miller discloses all the claimed subject matter, as set forth above in claim 8, and further discloses validating each of the claims for relief

Art Unit: 2161

comprises comparing the keycode received with each of the claims for relief against the pre-defined dataset as addressed above in claim 6.

Regarding claim 11, Spurgeon/Peterson/Dyson/Miller discloses wherein validating each of the claims for relief comprises:

- comparing a reference string provided to the claimant against a reference string received with each of the claims for relief; and
- comparing a keycode received with each of the claims for relief against the pre-defined dataset as addressed above in claim 6.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Dyson (US 6,269,399), in view of Peterson (US 6,343,271), and further in view of Ogilvie (US 6,343,738).

Regarding claim 18, Spurgeon/Peterson/Dyson discloses all the claimed subject matter, as set forth above in claim 1, however Spurgeon/Peterson/Dyson is silent as to receiving a digital signature uniquely identifying the source of each of the claims for relief. On the other hand, Ogilvie discloses using digital signature to authenticate information received (See col. 20, lines 31-34, Ogilvie et al.). It would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate or include digital signature in Spurgeon, as suggested by Ogilvie et al. The motivation would have been uniquely identifying which claimants sent claims for relief.

***Response to Arguments***

8. Applicant's arguments filed on 01/21/2005 about the claim rejection of the last Office Action have been fully considered, but they are not persuasive.

Applicant argues that Peterson fails to teach or suggest transmitting a computer application via a computer network, the computer application being configured to receive one or more claims for relief. The examiner respectfully disagrees. Peterson teaches this recitation as Column 9, lines 5 to 30 wherein upon a request from an employee in doctor's office 44, a claim form from the claims processing system is transmitted to the requestor for filing. The requestor uses suitable software executed thereon to enter the claim. Thus, Peterson reads on Applicant claimed recitation.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant is noted that there is error in listing which claims were rejected by which references in the Applicant's Remarks section on page 7, paragraph 2.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DiRienzo U.S Patent No. 6,076,066 discloses attachment integrated claims system and operating method therefor.

Joao U.S Patent No. 6,283,761 discloses apparatus and method for processing and/or for providing healthcare information and/or healthcare-related information.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*MN*

MN  
February 18, 2005

*Frantz Coby*  
**FRANTZ COBY**  
**PRIMARY EXAMINER**